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10/016,964	12/14/2001	Heidi Riedel	Beiersdorf 755-KGB	7321
7055 7590 02/23/2007 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			EXAMINER KANTAMNENI, SHOBHA	
			ART UNIT	PAPER NUMBER
			1617	
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		02/23/2007	ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 02/23/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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#### DETAILED ACTION

Applicant's amendment filed on 11/30/2006, wherein independent claims 18, 37, and 42 have been amended.

Applicant's amendment is sufficient to overcome the rejection of claims 18-43 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejection is herein withdrawn.

Applicant's arguments have been fully considered, but not found persuasive, and the rejection of claims 18-24, 28-31, 34, 36-39, 42, 43 under 35 U.S.C. 103(a) as being unpatentable over Bellon et al. (FR 2,789,397 with English translation of record) is MAINTAINED. See under response to arguments.

Applicant's arguments have been fully considered, but not found persuasive, and the rejection of claims 18-22, 28-33, 35, 42-43 under 35 U.S.C. 102(b) as being anticipated by Beutler et al. (US 4,808,388, PTO-1449) is MAINTAINED. See under response to arguments.

The nonstatutory obviousness-type double patenting rejection of claims 18-42 over claims 15-34, 43 of Application 10/469695; claims 16-31, 34-35, 45, 47, 48 of 10/469696; claims 17-32, 35-36, 47-48 of Application 10/469697; claims 14-29, 32-33, 42, 43 of Application 10/469698; claims 13-28, 31-32, 40 of Application 10/469074 is MAINTAINED. Note that applicant will decide whether it is necessary to file Terminal

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Disclaimer in the present application depending if the instant claims are indicated to be allowable subject matter.

Currently, claims 18-43 are pending in this application, and examined herein.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-24, 28-31, 34, 36-39, 42, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bellon et al. (FR 2,789,397 with English translation of record).

Bellon et al. exemplify a facial foam composition or preparation comprising 22% PEG-100 stearate glyceryl stearate which is a polyethoxylated fatty acid ester in the instant claim 18 (I)-B: stearate having a chain 18 carbons and 100 of ethoxylation; 12% stearic acid which is a fatty acid in the instant claim 18 (I)-A: stearic acid having a chain 18 carbons; 6% octyldodecanol, which is a fatty alcohol in the instant claim 1 (I)-C having a chain 20 carbons; nitrogen added to the composition in 70% by volume which is one gas in claim 18 (II). See Example 1 and Table 1 (at page 10-11 and 16 of the English translation). The claims therein recite a method of caring for skin comprising

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applying the composition to the skin. Bellon et al. disclose that the lipid phase in Example 1 which is phase A, is 40.7% of total weight which is obtained from the sum total of phase A (see page 11). Fatty acids such as stearic acid, myristic acid, acids of lauric, cetyl, palmitic, oleic are taught. It is also taught that lipophilic phase that includes the fatty acids represent 30 % of the lipophilic mass, and this lipophilic phase represents 5 % to 25 % by weight of the total composition. See page 5 of the English translation. A gas such as air, nitrogen in the amount of 10 to 90 % by volume of the composition is taught. See page 5 of the English translation. The compositions therein possess properties such as light appearance, good spreading power, quick penetration during use, non-greasy and non-sticky sensation to the skin after application. See page 4 of the English translation. The compositions therein can comprise additional emulsifiers such as for example glycerol stearate. See page 13, Example 2. See Example 3, wherein PEG-7 glycerylcocoate is present in an amount of 2.0 %.

Bellon et al. lacks a specific exemplification, wherein the total amount of emulsifiers A, B, and C is from 2 % to 20 % by weight as in claims 18, 42; from 5 % to 15 % as in claims 28 and 37; and from 8 % to 13 % by weight as in claim 29. Bellon et al. do not expressly disclose a ratio of a:b:c of 1:1:1.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to optimize the total amounts of a, b, and c, and a ratio of a:b:c of 1:1:1.

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to exemplify a composition wherein the total amount of emulsifiers

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A, B, and C is from 2 % to 20 % by weight as in claims 18, 42; from 5 % to 15 % as in claims 28 and 37; from 8 % to 13 % by weight as in claim 29, using the teachings of Bellon et al. with the expectation of achieving a cosmetically acceptable form of a foam that has a light texture and does not leave a residual greasy or sticky film.

Moreover, the optimization of the ratio of a:b:c based on the prior art teachings, is considered well within conventional skills in pharmaceutical science, involving merely routine skill in the art.

It has been held that it is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

The recitation “wherein the preparation comprises up to 30 % by weight, based on a total weight of the preparation, of a lipid phase comprising one or more nonpolar liquids”, and “wherein the preparation comprises up to 40 % by weight, based on a total weight of the preparation, of a lipid phase, of polar liquids” in claims 19-20 reads on 0 % weight of nonpolar liquids, and polar liquids.

### ***Response to Arguments***

Applicant argues that “Applicants point out that it is not even certain that the PEG-100 stearate glyceryl stearate used in Example 1 of BELLON falls within the definition of emulsifier B recited in the present independent claims.” This argument has been considered, but not found persuasive because PEG-100 stearate glyceryl stearate is a polyethoxylated fatty acid ester which is an ester of fatty acid having a chain length

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of 18 carbon atoms and polyethylene glycol comprising 100 ethylene glycol units, and thus meets the definition of B.

Applicant argues that "The oxyethylenated (or not) fatty acids of BELLON which may or may not be intended to encompass the PEG-100 stearate glyceryl stearate of Example 1 are mentioned, among many others, as (optional) traditional cosmetic adjuvants of the composition (see, e.g., page 8, second paragraph of the English language translation of BELLON)." This argument has been considered, but not found persuasive because Example 1 contains PEG-100 stearate glyceryl stearate, a polyethoxylated fatty ester.

Applicant argues that "one of ordinary skill in the art is not provided with any motivation whatsoever by BELLON to optimize the total amount of the combination of the three compounds which allegedly correspond to the present emulsifiers A to C in Example 1 thereof in any gas-containing cosmetic or dermatological preparation, let alone to reduce the total amount of these three compounds by at least about 13 % (i.e., more than a third) in comparison to that of Example 1 of BELLON." This argument has been considered, but not found persuasive because the percentage weights Applicant is relying upon is not the composition as a whole, but is the composition without nitrogen. Further, as pointed out in the above rejection, Bellon also teaches that the lipophilic phase, of which the emulsifiers are encompassed, comprises 5-25% of the composition as a whole.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25-27, 32, 33, 40, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bellon et al. as applied to claims 18-24, 28-31, 34, 36-39, 42, 43 above, and further in view of Synder (4,708,813).

Bellon et al. is applied as discussed above.

The reference lacks a hydrophilic emulsifier.

Bellon et al. does not teach the particular alcohols such as cetyl alcohol, and stearyl alcohol in the composition therein.

Synder teaches a nonlathering cleansing mousse with skin conditioning benefits. Sorbitan monostearate is taught as a surfactant that provides skin cleansing benefits and imparts a uniform dispersion of emollient and other ingredients in the composition. Surfactants are disclosed as comprising 1.5-15% of the composition. See abstract; Col. 4, line 26-Col. 5, line 24. Fatty alcohol foam modifiers, which are C12-C22 saturated chain fatty alcohols, for example cetyl alcohol, stearyl alcohol, lauryl alcohol, and mixtures thereof are taught. It is taught that these fatty alcohol enhance the stability of the mousse, and provide emollient effect on the skin. The fatty alcohols are present in an amount of 1 % to about 4 % in the composition. See column 3, lines 30-45.



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It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the sorbitan monostearate of Synder to the composition of Bellone et al. because of the expectation of achieving a composition with greater skin cleansing benefits and which imparts uniformity to the emulsion.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ fatty alcohols such as cetyl alcohol, stearyl alcohol in the composition of Bellone et al.

One of ordinary skill in the art would have been motivated to employ cetyl alcohol, stearyl alcohol as fatty alcohols with the expectation of obtaining a stable composition which provides emollient effect on the skin as taught by Synder.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bellone et al. as applied to claims 18-24, 28-31, 34, 36, 37-39, 42, 43 above, in view of Saint-Leger et al. (5,939,077).

Bellone et al. is applied as discussed above. The reference lacks carbon dioxide.

Saint-Leger et al. teach cosmetic compositions. Carbon dioxide and nitrogen are taught as interchangeable gases that are used in producing cosmetic foams. See Col. 4, lines 7-15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the nitrogen of Bellone et al. for carbon dioxide because Saint-Leger et al. teach carbon dioxide and nitrogen as equivalent gases for use in producing cosmetic foams.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18-22, 28-33, 35, 42-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Beutler et al. (US 4,808,388, PTO-1449).

Beutler et al. discloses foamable cosmetic creams for application onto the skin, comprising oil-in-water emulsion. The composition or preparation therein comprises 2 to 9 % by weight of emulsifying agent such as PEG glyceryl stearate, PEG 9-stearate, cetareth-12 (PEG-12-cetyl stearyl ether), and mixtures thereof; 0.5 to 4.5 % by weight of consistency-providing agent, a combination of cetearyl alcohol and stearic acid; 4.5 to 21 % by weight of oil portion selected from fatty substances such as vegetable and mineral oil, liquid fatty alcohols, and liquid waxes; and gases such as N<sub>2</sub>O, CO<sub>2</sub>. See column 2, lines 3-10; lines 28-50. A composition comprising 2.0 % by weight of cetareth-12 (PEG-12-cetyl stearyl ether), 1.0 % by weight of cetearyl alcohol, and 2.5 % by weight of stearic acid, and 2 to 3.2 % by weight of a gas such as N<sub>2</sub>O, CO<sub>2</sub> is disclosed. See Example 7/2; column 20, claims 1-4. The composition therein comprises a total of 2.5 % to 13.5 % by weight of polyethoxylated fatty acid esters, cetearyl alcohol, and stearic acid. A method of preparing said compositions is also taught.

Thus, Beutler et al. anticipates instant claims 18-22, 28-33, 35, 42-43.

***Response to Arguments***

Applicant argues that "present independent claims 18 and 42 recite the presence of at least one emulsifier B, i.e., of an ester of a fatty acid having a chain length of from 10-40 carbon atoms and polyethylene glycol comprising from 5 to 100 ethylene glycol units and/or of a polyethoxylated fatty acid ester having a chain length of from 10 to 40 carbon atoms and a degree of ethoxylation of from 5 to 100. The composition of Example 7/2 of BEUTLER does not contain a corresponding compound and neither does the remaining disclosures of BEUTLER appear to teach a composition which could be considered to anticipate the subject matter of any of the present claims." This argument has been considered, but not found persuasive because Beutler et al. discloses a composition or preparation comprising 2 to 9 % by weight of nonionic emulsifying agent such as PEG glyceryl stearate, PEG Stearate, such as PEG 9-stearate, and mixtures thereof; 0.5 to 4.5 % by weight of consistency-providing agent, a combination of cetearyl alcohol and stearic acid; 4.5 to 21 % by weight of oil portion selected from fatty substances such as vegetable and mineral oil, liquid fatty alcohols, and liquid waxes; and gases such as N<sub>2</sub>O, CO<sub>2</sub>. See column 2, lines 3-10; lines 28-50; see Example 4/2, where in PEG 9-stearate is taught as a nonionic emulsifying agent. Thus, Beutler et al. anticipates instant claims 18-22, 28-33, 35, 42-43.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 42 is rejected under 35 U.S.C. 102(b) as being anticipated by Penksa et al. (EP 0 938 890, PTO-1449, IDS filed on 06/20/2006).

Penkas et al. discloses skin care compositions containing a liquid, inert, hydrofluorocarbon infused with carbon dioxide. The compositions therein comprise 3 % by weight of stearic acid, 0.5 % by weight of cetyl alcohol, 0.5 % by weight of peg-100 stearate. See paragraphs [0016], [0019], [0072] to [0073], EXAMPLES 6-7. The method of preparing said compositions is also disclosed.

Thus, Penkas et al. anticipates instant claim 42.

***Response to Arguments***

Applicant's argument that "Applicants are unable to see that the compositions of Examples of 6 and 7 of PENSKA are indicated to be self-foaming and/or foam-like." This argument has been considered, but not found persuasive because the compositions disclosed by Penska et al. comprise fluorocarbons infused with carbon dioxide, and thus will inherently render the preparation self-foaming and/or foam-like. Thus, Penkas et al. anticipates instant claim 42.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 42 is rejected under 35 U.S.C. 102(b) as being anticipated by Marilyn.  
(WO 92/16188, PTO-1449).

Marilyn discloses self foaming shave cream compositions comprising 6.58 % by weight of palmitic acid, 0.97 % by weight of stearyl alcohol, 0.15 % by weight of PEG-150 stearic acid diester, and about 3.24 % of a propellant. It is also disclosed that the PEG distearate, a fatty acid diester of the polyethylene glycol should have a molecular weight of at least about 1000, preferably at least about 6000. The method of preparing said compositions is also disclosed. See page 7, lines 34-37; page 8, Example I; page 11, claims 1, 6.

Thus, Marilyn anticipates instant claim 42.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 18-41 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15-34, 43 of Application 10/469695; claims 16-31, 34-35, 45, 47, 48 of 10/469696; claims 17-32, 35-36, 47-48 of Application 10/469697; claims 14-29, 32-33, 42, 43 of Application 10/469698; claims 13-28, 31-32, 40 of Application 10/469074. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are drawn to a cosmetic or dermatological preparation comprising emulsifiers A, B, C, wherein the total weight % of emulsifiers A, B, and C is 2 to 20 % by weight, and 1% to 90 % by volume of a gas, and the claims of '695, '696, '697, '698, '074 are drawn to a cosmetic or dermatological composition comprising emulsifiers A, B, C, and 1 % to 90 % by volume of a gas.

Applications '695, '696, 697, 698, 074 lack a specific exemplification, wherein the total amount of emulsifiers A, B, and C is from 2 % to 20 % by weight based on the total weight of the preparation. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to optimize the amounts and a ratios of A:B:C of 1:1:1 with the expectation of achieving a cosmetically acceptable form of a foam that has a light texture and does not leave a residual greasy or sticky film.

Therefore, the instant claims 18-41 are seen to be obvious over the claims of application '695, '696, '697, '698, '074.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 42 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15-17 of Application 10/760088. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are drawn to a method of preparing a self-foaming cosmetic or dermatological preparation comprising a gaseous ingredient, and emulsifiers A, B, C, wherein the total weight % of emulsifiers A, B, and C is 2 to 20 % by weight, and the claims of '088 are drawn to a method of producing a foamable cosmetic or dermatological composition comprising combining a gaseous ingredient with emulsifiers A, B, C, and a gaseous ingredient.

Application '088 lacks a specific exemplification, wherein the total amount of emulsifiers A, B, and C is from 2 % to 20 % by weight based on the total weight of the preparation. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to optimize the amounts and a ratios of A:B:C of 1:1:1 with the expectation of achieving a cosmetically acceptable form of a foam that has a light texture and does not leave a residual greasy or sticky film.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period, will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shobha Kantamneni whose telephone number is 571-272-2930. The examiner can normally be reached on Monday-Tuesday, Thursday-Friday, 8am-4pm.

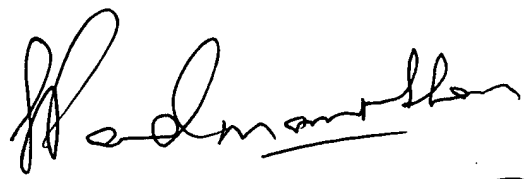
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, Ph.D can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shobha Kantamneni, Ph.D  
Patent Examiner  
Art Unit 1617.

  
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